REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claim 18 has been amended, claims 23-24 have been added, and claims 19, 21, and 22 have been canceled. No new matter has been added. Thus, claims 10-18, 20, and 23-24 are currently pending in the present application and subject to examination.

In the Office Action mailed April 26, 2006, the Examiner rejected claims 10-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,328,570 to Ng ("Ng") in view of U.S. Patent No. 5,838,577 to Tokano ("Tokano"). The Applicants hereby traverse the rejections as follows.

Applicants' invention as currently set forth in clam 10 is directed to a method for executing a program stored on a memory cartridge comprising providing a single memory cartridge storing each of at least one karaoke program and at least one game program, determining whether the memory cartridge is attached to a main body of a karaoke apparatus, determining whether the memory cartridge is attached to a main body of a gaming apparatus that is separate from the karaoke apparatus, if the memory cartridge is attached to the main body of a karaoke apparatus, selecting a karaoke program from the at least one karaoke program stored on the memory cartridge, and if the memory cartridge is attached to the main body of a gaming apparatus, selecting a game program from the at least one game program stored on the memory cartridge.

This allows programs having different purposes to operate in apparatuses having different natures to be accommodated in a single cartridge.

Ng teaches a karaoke device having a game function. Thus, Ng does not disclose or suggest at least the features of determining whether the memory cartridge is attached to a main body of a gaming apparatus that is separate from the karaoke apparatus, as claimed in claim 10. In Ng, users use the cartridge only in the karaoke apparatus, and the system does not determine whether the memory cartridge is attached to a main body of a gaming apparatus that is separate from the karaoke apparatus. As the same cartridge is used in the same apparatus, it is not necessary to determine what kind of apparatus to which the cartridge is attached.

Tokano fails to cure the deficiency in Ng.

In the present invention, as claimed in claim 10, a determination is made, not as to whether the cartridge is generally attached to an apparatus, but as to which one of a karaoke and game apparatus the cartridge is attached. This never occurs in Ng or Tokano because neither Ng or Tokano disclose or suggest a cartridge capable of being used in both a karaoke machine and a separate game machine.

In addition, in Ng, if the memory cartridge is attached to the main body of a karaoke apparatus, either a karaoke or a game program may be selected. The system does not disclose or suggest the claimed steps of if the memory cartridge is attached to the main body of a karaoke apparatus, selecting a karaoke program from the at least one karaoke program stored on the memory cartridge, and if the memory cartridge is attached to the main body of a gaming apparatus, selecting a game program from the at least one game program stored on the memory cartridge, as claimed in claim 10.

In the Examiner's Response to Arguments, the Examiner suggests that the cartridge of Ng could be used in the Karaoke apparatus of Ng as well as the game

apparatus of Nintendo. However, the Examiner shows neither documents to support such a combination nor documents showing a motivation for providing such a compatible cartridge by combining Ng with the teachings of others.

The invention, as currently claimed in claim 10, makes it possible to play a game in a separate game apparatus with the same music as the music used in a separate karaoke apparatus or with music of a singer who sings music in the karaoke apparatus.

Neither Ng, nor any of the other cited references disclose or suggest a cartridge that is capable of being attached to both a karaoke apparatus and a separate game apparatus and is capable of starting different applications in the karaoke apparatus and the game apparatus, respectively.

The Examiner cited Weinstein as teaching the inclusion of multiple data types readable by multiple separate devices on a singular medium. Weinstein discloses a storage medium which stores different programs for a DOS system and a Macintosh system. However, these programs are both operating systems having the same purpose and the same nature, with different specifications. This is a storage medium that can be used in a personal computer of one type and another type of personal computer, similar to a karaoke cartridge that is compatible with more than one type of karaoke machine, or a cartridge that can be used in one game apparatus and another, different game apparatus. In contrast, the present invention, as claimed in claim 10, accommodates in one cartridge programs having different operating purposes in apparatuses having different natures.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of

obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 5. This is an insufficient showing of motivation.

For at least these reasons, the Applicants submit that claim 10 is allowable over the cited art. The Applicants submit that claim 20 is allowable for similar reasons. As claims 10 and 20 are allowable, claims 11-18 and 23-24, which depend from allowable claims 10 and 20, are, therefore, also allowable for at least the above noted reasons and for the additional limitations they provide.

CONCLUSION

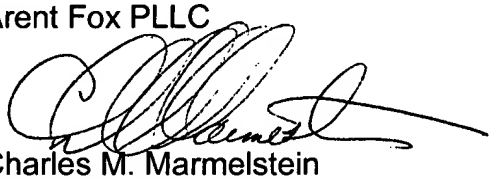
For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 100341-00017.

Respectfully submitted,

Arent Fox PLLC



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